



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,174	11/19/2003	Matthew Vulich	03183249	9346
26565	7590	11/12/2004		
MAYER, BROWN, ROWE & MAW LLP 190 SOUTH LASALLE ST CHICAGO, IL 60603-3441			EXAMINER MCDONALD, SHANTESE L	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 11/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/718,174

Applicant(s)

VULICH ET AL.

Examiner

Shantese L. McDonald

Art Unit

3723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 09 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 11-18 is/are allowed.
- 6) ☐ Claim(s) 1,4,7,8,10,19-24 and 26 is/are rejected.
- 7) ☐ Claim(s) 2,3,5,6,9,25,27 and 28 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/9/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,4,7,8 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Savoie.

Savoie teaches a tool for gripping ophthalmic lenses comprising at least one vacuum gripper, 14, a shaft, 120 associated with the gripper, the shaft having two ends and being slidably attached at one end thereof to a support structure, 112, a resilient member, which is a spring, 124, which biases the gripper in a direction away from the support structure, and a pneumatically operated locking member, 122, which comprises a piston and cylinder, 140, connected to a friction pad, 134, and the friction pad engaging a flat portion of the shaft during lens gripping operations, (col. 9, line 63 – col. 10, line 56).

Claims 19-22 are rejected under 35 U.S.C. 102(b) as being anticipated by Ulloa.

Ulloa teaches a server, a robotic arm, 10, a plurality of edging machines, 35, 40, which have openings that face away from the robotic arm, and which communicate with the robotic arm through communication ports, (col. 4, line 10 – col. 6, line 26).

Claims 23,24 and 26 are rejected under 35 U.S.C. 102(b) as being anticipated by Obayashi.

Obayashi teaches an ophthalmic edging machine, 310L, 310R, at least two rails, which contain at least one groove, wherein the edging machine includes a bracket that engages the rails and a locking mechanism that holds the edging machine in a desired position along the rails, (col. 7, line 59 – col. 8, line 12, fig. 1)

Allowable Subject Matter

Claims 2,3,5,6,9,25,27 and 28 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 11-18 are allowed.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bouillon et al. was cited to show another example of a lens holder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shantese L. McDonald whose telephone number is (703) 308-8722. The examiner can normally be reached on 8:00 a.m. - 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on (703) 308-2687. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.L.M.
November 4, 2004

A handwritten signature in black ink, appearing to read "Joseph J. Hail, III". The signature is fluid and cursive, with a large initial "J" and a stylized "H".

Joseph J. Hail, III
Supervisory Patent Examiner
Technology Center 3700